



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0654

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Gerard LANG *et al.*

Application No.: 09/600,134

Filed: September 11, 2000

For: KERATINOUS FIBRE OXIDATION
DYEING COMPOSITION
CONTAINING A LACCASE AND
DYEING METHOD USING SAME

Group Art Unit: 1751

Examiner: Eisa B. Elhilo

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Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Pursuant to 37 C.F.R. § 1.193, Appellants present in triplicate their Reply to the Examiner's Answer dated August 28, 2003. If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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REMARKS

I. Grouping of Claims

The Examiner contends that the Appeal Brief "does not include a statement that this grouping of claims does not stand or fall together. . . ." Answer, page 2. The Examiner is in error. Appellants stated in section "Groupings of Claims" on page 4 of the Appeal Brief that "pursuant to 37 C.F.R. § 1.192(c)(7), in this Appeal, the rejected claims will stand or fall together."

II. Status of Rejections

In response to the Appeal Brief filed June 9, 2003, the Examiner has maintained his rejection of claims 22-58 under 35 U.S.C. § 103(a) as being unpatentable over International Application No. WO 97/19999 to Aaslyng ("Aaslyng") in view of U.S. Patent No. 5,769,903 to Audousset ("Audousset").

III. Response to Examiner's Arguments in the Answer

The Examiner maintains the rejection of claims 22-58 under 35 U.S.C. § 103(a) as being unpatentable over Aaslyng in view of Audousset. Appellants maintain that a prima facie case of obviousness has not been established for the reasons set forth in the Appeal Brief filed June 9, 2003, as well as those emphasized below.

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based

obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a *prima facie* case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added). The Federal Circuit reaffirmed the Examiner's high burden to establish a *prima facie* case of obviousness in *In re Lee*, where the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Lee at 1433-1434 (internal citations and quotation omitted) (emphasis added).

THERE IS NO MOTIVATION TO COMBINE AASLYNG WITH AUDOUSSET

The Examiner continues to allege that Aaslyng discloses "the genus of para-aminophenol (see page 9, line 25)". Answer, page 5. The Examiner has not yet addressed Appellants contention that Aaslyng only discloses the single species, para-aminophenol, and does not disclose a genus of para-aminophenols.

Appellants maintain that Aaslyng discloses the singular para-aminophenol as a

species of oxidation base, rather than the plural genus of para-aminophenols as alleged by the Examiner. For example, Aaslyng at page 9, line 23, to page 10, line 19, discloses a large number of dye precursor species (such as p-aminophenol and o-aminophenol) and several genera of dye precursors (such as phenazines, p-amino-benzoic acids) with examples of species within each of the genera. In each instance, one of ordinary skill would understand which is a species and which is a genus. In particular, p-aminophenol is clearly identified as a single species and all genera are clearly recognizable as genera because of the use of the plural and the disclosure of species within the genus. For this reason, Appellants submit that Aaslyng fails to disclose the genus of para-aminophenol as asserted by the Examiner.

Furthermore, since Aaslyng merely teaches the singular species para-aminophenol and Audousset discloses 4-amino-3-methylphenol, Appellants submit that the Examiner has failed to provide any motivation for the combination. Such motivation is lacking at least because merely selecting certain possible components from each reference to devise the composition of the claimed invention, without further motivation in the art, is an insufficient basis for maintaining a prima facie case of obviousness. Indeed, the Examiner has not provided any substantial evidence for substituting Aaslyng's para-aminophenol species with Audousset's 4-amino-3-methylphenol species.

In addition, the Examiner has still failed to provide adequate motivation for the combination because Audousset merely teaches compositions comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. See Audousset, column 2, line 10 to column 3, line 58. The composition of Audousset is substantially dissimilar to the composition of Aaslyng, which comprises a laccase enzyme and at least one dye precursor. See Aaslyng abstract. Appellants respectfully submit that the Examiner has not properly pointed to anything in the references that would have led to the addition of Audousset's 3-methyl-4-aminophenol oxidation base to the composition of Aaslyng. The Examiner has therefore failed to provide substantial evidence of why one of ordinary skill in the art would have been motivated to combine these two references to devise a particular composition comprising an oxidation base chosen from 3-methyl-4-aminophenol and the addition salts thereof, and at least one laccase enzyme.

Accordingly, Appellants respectfully request reconsideration and withdrawal of the rejection.

IV. Conclusion

For the foregoing reasons, and the reasons of record, the Examiner's rejection of the claims is improper and should be withdrawn. Appellants respectfully request that the rejection be reversed and withdrawn.

Please grant any extensions of time required to enter this reply brief and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Date: October 28, 2003

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